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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,953	12/30/2003	Mary Rose Rice	076360.011600(275-3119-U)	7896
33717 7590 06/15/2009 GREENBERG TRAURIG LLP (L.A.) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404			EXAMINER CASCHIERA, ANTONIO A	
			ART UNIT 2628	PAPER NUMBER
			MAIL DATE 06/15/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/748,953

**Applicant(s)**

RICE, MARY ROSE

**Examiner**

Antonio A. Caschera

**Art Unit**

2628

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8, 10, 12-15 and 45-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 8, 10, 45-49 and 60-66 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 12-15, 50-59 and 67-77 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-949)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 54-56 are objected to because of the following informalities:
  - a. These claims comprise the preamble of, “The display unit of claim x” however the preamble should read, “The apparatus of claim x” in order to conform with claim 1’s apparatus, from which claims 54-56 ultimately depend upon..

Appropriate correction is required.

2. Claims 12 and 67 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
3. Claim 50 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 45. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Response to Arguments***

4. Applicant's arguments, see page 12 of Applicant's Remarks, filed 05/01/09, with respect to the 35 USC 101 rejection of claims 1-6, 45-49, 54-56 and 67-77 have been fully considered and are persuasive. The 35 USC 101 rejection of these claims has been withdrawn. Note, the amendments made to some of the independent claim have now created duplicates between the independent claims of the Application.

*Allowable Subject Matter*

5. Claims 1-6, 8, 10, 45-49 and 60-66 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

In reference to claims 1 and 8, the prior art of record does not explicitly disclose arranging a first plurality of physical paint sample cards on a display unit so that they are arranged in groups of varying hue in a first direction and chroma in a second direction while further arranging one or more combination or coordination paint sample cards adjacent each group of different hue and chroma physical paint sample cards, each color combination or coordination paint sample card containing a plurality of paint samples having the same base hue as the hue of a group it is adjacent to with a picture of a building or room painted with the plurality of colors on the color combination paint sample card, in combination with the further limitations of claims 1 and 8 respectively.

In reference to claims 1-6 and 10, claims 1-6 and 10 depend upon allowable claims 1 and 8 respectively and are therefore also deemed allowable.

In reference to claim 45, the prior art of record does not explicitly disclose a first plurality of paint sample cards arranged in hue groups, arranging one or more color combination style

cards adjacent to each group of different hue, each combination card having a tri-fold card with three separate sections, each section containing a plurality of paint samples and a picture of a room painted with the plurality of paint samples on the section, each section of the tri-fold card having a picture of a different room, in combination with the further limitations of claim 45.

In reference to claims 46-49, claims 46-49 depend upon allowable claim 45 and are therefore also deemed allowable.

In reference to claim 60, the prior art of record does not explicitly disclose a first plurality of physical color combination cards including a plurality of paint samples which includes at least a base hue sample and a plurality of complementary color samples arranged adjacent to the base hue sample and having a picture a room or building that is painted with the plurality of paint samples, in combination with the further limitations of claim 60.

In reference to claims 61-66, claims 61-66 depend upon allowable claim 60 and are therefore also deemed allowable.

### *References Cited*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
  - a. Sorensen (U.S. Patent 5,312,001)
    - i. Sorensen discloses a display assembly for sequentially dispensing a plurality of card-like samples in an upright position.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781. The examiner can normally be reached Monday-Friday between 7:00 AM and 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung, can be reached at (571) 272-7794.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**571-273-8300 (Central Fax)**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (571) 272-2600.

/Antonio A Caschera/

Primary Examiner, Art Unit 2628

**6/15/09**